

Applicant : Charles P. McShane et al.  
Serial No. : 10/619,893  
Filed : July 15, 2003  
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Attorney's Docket No.: 08215-301003 / P06-023937

### REMARKS

Claims 127-140, 142-145, 148-155, and 157-185 are pending in the application.

In this response, claims 133-140, 142-145, 154-155, 157-162, 175-176, 178-180 and 182-184 are amended. The claims are amended to make clear that the dielectric fluid may consist of one or more vegetable oils and one or more antioxidant compounds. The language regarding the one or more vegetable oils is supported in the specification, for example, on page 7, lines 19-20 (see also col. 6, lines 50-52 of U.S. Patent No. 6,037,537). The language regarding the one or more antioxidants is supported in the specification, for example on page 13, lines 10-11 (see also col. 6, lines 52-55 of U.S. Patent No. 6,037,537).

Claims 127-132, 148-153 and 163-174 are canceled without prejudice or disclaimer, and Applicants reserve the right to file at a later date a continuation application directed to the subject matter of these claims.

The correct chemical names for BHA, BHT, TBHQ and THBP have been inserted in the paragraph at page 13, line 8 of the specification.

In view of the above amendments and the following remarks, Applicants respectfully request further examination of this application and reconsideration of the objections and rejections set forth in the Office Action mailed July 16, 2004.

#### **I. Claim Objections**

On page 2 of the Office Action, paragraph 1, claims 128, 131, 134, 137, 140, 143, 149, 152, 155, 158, 161, 167, 270, 173, and 177 are objected to as including abbreviations for some of the listed antioxidant compounds.

In response to this objection, claims 134, 137, 140, 143, 155, 158, 161, 176 and 180 are amended to include complete spelling of the chemical compound names. In addition, the correct chemical names for BHA, BHT, TBHQ and THBP have been inserted in the paragraph at page 13, line 8 of the specification.

Reconsideration and withdrawal of these objections are respectfully requested.

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## **II. Claim Rejections – 35 U.S.C. § 112**

On page 2 of the Office Action, paragraphs 2-3, claims 135, 138, 144, 159, 162, 176, 180 and 185 are rejected under the second paragraph of 35 U.S.C. § 112 as indefinite for failure to particularly point out and distinctly claim the inventive subject matter.

In response to this rejection, claims 135, 138, 144, 159, 162, 177, 181 and 185 are amended to replace “further comprising” with “further consists of” to clarify the closed ended nature of the independent claims from which they depend.

Reconsideration and withdrawal of these rejections are respectfully requested.

## **III. Claim Rejections – 35 U.S.C. § 103(a)**

On pages 2-4 of the Office Action, paragraphs 4-7, claims 127, 130, 148, 151, 163, 166, 169 and 172 are rejected under 35 U.S.C. § 103(a) as obvious over Clark (U.S. Patent No. 1,935,595) in view of Sato et al. (U.S. Patent No. 4,681,980).

In response to this rejection, claims 127-132, 148-153 and 163-174 are canceled without prejudice or disclaimer, and for the sole and exclusive purpose of gaining prompt allowance of the amended claims above. Applicants intend to file at a later date a continuation application directed to the subject matter of these claims. Reconsideration and withdrawal of the cited rejection are respectfully requested.

## **IV. Claim Rejections – 35 U.S.C. § 103(a)**

On pages 4-5 of the Office Action, paragraphs 8-9, claims 127-132, 148-153 and 163-174 are rejected under 35 U.S.C. § 103(a) as obvious over Clark and Sato et al., and further in view of Shedigan (U.S. Patent No. 4,511,949).

As noted above in paragraph III of this response, claims 127-132, 148-153 and 163-174 are canceled without prejudice or disclaimer, and for the sole and exclusive purpose of gaining prompt allowance of the amended claims above. Applicants intend to file at a later date a continuation application directed to the subject matter of these claims. Reconsideration and withdrawal of the cited rejection are respectfully requested.

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#### **V. Double Patenting**

On pages 5-6 of the Office Action, paragraphs 10-11, claims 127-140, 142-145, 148-155 and 157-185 are rejected under the judicially created doctrine of double patenting over claims 1-27 of U.S. Patent No. 6,037,537.

In response to this rejection, Applicants submit the attached terminal disclaimer under 37 C.F.R. § 1.321(c). Reconsideration and withdrawal of the cited rejection are respectfully requested.

#### **VI. Allowable Subject Matter**

On page 6 of the Office Action, paragraph 12, claims 133-134, 136-137, 139-140, 142-143, 145, 154-155, 157-158, 160-161, 175, 178-179 and 182-184 are designated as allowable.

Applicants wish to thank the Examiner for this indication of allowability, and respectfully submit that claims 177 and 181 appear to be allowable as well.

#### **VII. Conclusion**

In view of the above amendments and remarks, Applicants respectfully request reconsideration of the cited rejections, and allowance of all claims at an early date. If questions remain regarding the above, please contact the undersigned.

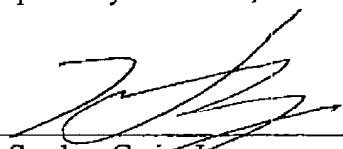
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Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: September 3, 2004

  
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